

The rejection of claims 1-2 and 12-13 is moot in view of the cancellation of those claims. Claim 14 has been amended to include the substance of claims 15 and 16, which have been cancelled. Regarding amended claim 14, this finding of anticipation requires that all the elements of amended claim 14 be disclosed in Tindall.

To constitute an anticipation, a reference must contain each and every element of the rejected claim within its teachings; absence of a claim element from a prior art reference negates anticipation. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 224 USPQ 409 (Fed. Cir. 1984). [96.23 - KAL. 96.26 - RL]

It is well established that a rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994). [96.26 - RL]

Tindall does not anticipate claim 14 as amended, because Tindall does not disclose a deformable grip comprising a viscous medium enclosed by a deformable outer surface. The Examiner has, himself noted this. Page 5, last paragraph of the office action reads, "Tindall discloses the invention essentially as claimed except for the viscous material." Based on this admission by the Examiner, applicant assumes that the Examiner will agree that amended claim 14 is not anticipated by Tindall.

Anticipation of Claims 1-10 by McCall et al. (US 5,000,599)

Moot in view of the cancellation of claims 1-10.

Anticipation of Claims 1 and 2 by Racodon (US 5,848,453)

Moot in view of the cancellation of claims 1-2.

Anticipation of Claims 1, 2 and 13 by Lo (US 4,837,892)

Moot in view of the cancellation of claims 1, 2 and 13.

Anticipation of Claims 1-4 by D'Haem, et al. (US 4,044,625)

Moot in view of the cancellation of claims 1-4.

Obviousness of Claims 3-10 and 16-24 over Tindall (US 970,406) in view of McCall, et al. (US 5,000,599)

The rejection of claims 3-10 is moot in view of the cancellation of those claims. Claim 16 has been incorporated into claim 14. Independent claim 14 and dependent claims 17-24 are not obvious over Tindall in view of McCall. The Examiner has failed to point out where in the references is the motivation for modifying Tindall in view of McCall. The Examiner's assertions concerning what would have been obvious to a person of ordinary skill in the art cannot be substituted for a reasoned explanation based the disclosures of the cited references. This point is made quite forcefully in the recent decision, in re Lee (Fed. Cir., No. 00-1158, 1/18/02), a portion reproduced here, emphasis added.

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g.,

*Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998));

*In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.");

*In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant);

*In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g.,

*In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed");

*In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill,

that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.");

In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

This court explained in Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697, that "deficiencies of the cited references cannot be remedied by... general conclusions about what is 'basic knowledge' or 'common sense.'" The Board's findings must extend to all material facts and must be documented on the record, lest the "haze of so-called expertise" acquire insulation from accountability. "Common knowledge and common sense," even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority. See Allentown Mack, 522 U.S. at 376 ("Because reasoned decisionmaking demands it, and because the systemic consequences of any other approach are unacceptable, the Board must be required to apply in fact the clearly understood legal standards that it enunciates in principle . . . .")

The case on which the Board relies for its departure from precedent, In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969), indeed mentions "common knowledge and common sense," the CCPA stating that the phrase was used by the Solicitor to support the Board's conclusion of obviousness based on evidence in the prior art. Bozek did not hold that common knowledge and common sense are a substitute for evidence, but only that they may be applied to analysis of the evidence. Bozek did not hold that objective analysis, proper authority, and reasoned findings can be omitted from Board decisions. Nor does Bozek, after thirty-two years of isolation, outweigh the dozens of rulings of the Federal Circuit and the Court of Customs and Patent Appeals that determination of patentability must be based on evidence. This court has remarked, in Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc., 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1421 (Fed. Cir. 1999), that Bozek's reference to common knowledge "does not in and of itself make it so" absent evidence of such knowledge.

The determination of patentability on the ground of unobviousness is ultimately one of judgment. In furtherance of the judgmental process, the patent examination procedure serves both to find, and to place on the official record, that which has been considered with respect to patentability. The patent examiner and the Board are deemed to have experience in the field of the invention; however, this experience, insofar as applied to the determination of patentability, must be applied from the viewpoint of "the person having ordinary skill in the art to which said subject matter pertains," the words of section 103. In finding the relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

In the present case, the Examiner has done that which in re Lee so forcefully denounces as a failure on the part of the Patent Office. In support of his rejection, the Examiner has written, "It would have been obvious to one skilled in the art to fill the grips of Tindall with a viscous medium as taught by McCall et al in order that the grip will deform to the anatomical contours of the individual user in a custom fit manner and retain the deformation for a substantial period of time, for example at least five seconds." This is exactly the type of unsupported, conclusory statement that the Court of Appeals has clearly labeled as wrong. This explanation by the Examiner lacks "objective evidence of record", "a showing of a suggestion, teaching, or motivation to combine", "specificity", and "the reasoning by which the findings are deemed to support the agency's conclusion". Applicant cannot say forcefully enough that the Examiner has failed in his obligation to explain this obviousness rejection. It is not enough to assert opinion as to what is obvious, rather the Examiner must place on the record why he believes that the references suggest that they should be combined and how that combination reads on the claimed invention. In this case, the Examiner has not done so. Therefore, the Examiner has not met the burden of prima facie obviousness. The Examiner is invited to place on the record a reasoned statement based on the evidence found in Tindall and McCall that supports their combination. Failing this, the applicant respectfully requests that this rejection be dropped and the all remaining claims be allowed.

Amended claims 17 and 21 form progressively more sophisticated embodiments of the present invention than claim 14. Even if the Examiner could make a reasoned statement, based on the evidence found in Tindall and McCall, to support an obviousness rejection of claim 14, these more sophisticated embodiments are still non-obvious. For example, where in either reference is it suggested to modify the simple air-filled tubular grip of Tindall with a more sophisticated grip comprising an inner surface and a system of chambers and vents for regulating the flow of a viscous medium through the grip? The "fact that references can be combined or modified is not sufficient to establish prima facie obvious" MPEP 2143.01. Even if the substitution of a viscous medium for air is obvious (and the Examiner has not shown how it is) certainly shears with grips comprising an inner surface and further, a system of chambers and vents for regulating the flow of a viscous medium, are not obvious. It may be doable, but that does not make it obvious. The Examiner cannot simply say it's obvious to put the more sophisticated grips of claims 17 and 21 onto Tindall's shears without supplying a motivation for so doing. Absent a reasoned statement explaining this motivation, the applicant is left wondering if the Examiner has applied impermissible hindsight. The Examiner's rejection does not even mention the elements of claims 17 and 21. Without some rationale placed on the record the applicant is placed in the difficult position of having nothing objective to rebut. Of course, this is exactly the danger of impermissible hindsight. The Examiner has failed to explain the motivation for modifying Tindall in view of McCall to meet claims 17 and 21 and, in fact, no such motivation exists. Allowance of these claims is respectfully requested.

Respectfully submitted,

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## Claims With Markings To Show Changes

14 (Amended). Shears comprising:

a head [region] that contains one or more elements adapted to be directed toward the hair;

a handle [region] comprising finger loops, each finger loop having an inner diameter;  
and

deformable grips located on each inner diameter, each grip having:

a deformable outer surface capable of receiving at least a portion of the inner diameter into itself; and

a viscous medium enclosed by the outer surface.

17 (Amended). The shears of claim [16] 14 in which each grip further comprises an inner surface [is] positioned [between the inner diameter and the viscous medium] so that the viscous medium is located between the inner and outer surfaces.

18 (Amended). The shears of claim [16] 14 in which the viscous medium is a putty.

20 (Amended). The shears of claim [16] 14 in which the viscous medium is a room-temperature curable substance.

21 (Amended). The shears of claim [14] 17 in which each deformable grip further comprises [an inner surface and an outer surface, the inner and outer surfaces being connected by] radially oriented webs that connect the inner and outer surfaces and that define [defining] chambers [containing] which contain the viscous medium [within each grip], wherein each web contains [containing] at least one vent [dimensioned so as to permit the passage of the viscous medium from one chamber to another when pressure is paced on the grip].

24 (Twice Amended). The shears of claim [13] 14 wherein each grip comprises a groove that receives at least a portion of the inner diameter into itself, the groove being formed by folding the grip in on itself.